



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,293	05/25/2001	Michael E. Aufricht	1933.0010008	3536

26111 7590 04/25/2006

STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
----------

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/864,293

Applicant(s)

AUFRICHT ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-12 and 16-27 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 3/22/06 is insufficient to overcome the prior rejection.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/22/06 has been entered.

#### ***Priority***

4. Applicant's statement that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390 is noted. However, the Examiner notes that this Application, 09/864,293, does not benefit from an earlier filing date. There is inadequate support under 35 USC 112 in the CIP applications. The CIP applications do not disclose any pre-populating of an advertisement with address location information related to the user. Hence, the present application, 09/864,293, has a priority date to the present application's filing date which is 5/25/2001.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 6, 7, 9-11, 16, 17, 19, 21, 22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396).

Claim 1, 2, 4, 6, 16, 17, 19, 21: Shaw discloses computer implemented method for placing advertisements with interactive content on devices, comprising the steps of:

- (1) displaying an advertisement with interactive content on a device (Fig. 10),
- (2) pre-populating at least one field of the advertisement with address location information relating to the user of the device;
- (3) conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity:

“(39) By clicking on the banner advertisement 800, the user may be provided with an e-mail message template to create an e-mail message (as described in connection with FIG. 12 below), having the addressee already filled in with the e-mail address of a company associated with the subject matter of the current banner advertisement 800. In this manner, the user may, for example, provide comments to the company regarding the subject matter of the banner advertisement 800 or request further information. Alternatively, clicking on the banner advertisement 800 may cause an e-mail message to be automatically completed (including the

Art Unit: 3622

message) and either transmitted immediately or stored in the user's "outbox" folder (described later). The message may merely identify the user to the addressee of the e-mail message as someone interested in the subject matter of the banner advertisement 800 (col 13, line 55-col 14, line 5);

(23) The first time that the client computer software is executed on the client computer 101 (and whenever a user wishes to establish a new account with the server system 104), the client program performs various function intended to establish a new account for the user. In the representative embodiment, the first step is to collect new account information (step 301). At the request of the client program, the user inputs name, address, telephone number and other identification data. This information is stored on storage device 206 (col 11, lines 48-60);

(32) It will be appreciated that in alternative embodiments, the member profile may be transmitted to the server system 104 at step 304 along with the selected e-mail address and password" (col 12, lines 62-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that user address information can be sent along with the pre-filled email. One would have been motivated to do this in order to provide relevant user information for better profiling and tracking of the user.

Shaw further discloses caching content (col 2, lines 25-35).

Therefore, it would be obvious to one skilled in the art that Shaw's content which is forwarded can be done so at a later time. One would be motivated to do this in order to allow greater off-line utilization.

Additionally, Shaw further discloses utilizing an ISP provider:

“(10) There are a number of ways that a user can connect to the Internet to send and receive e-mail. A user can have an account with a proprietary on-line network, such as, for example, Prodigy, America Online, CompuServe or Microsoft Network. Using a computer with a modem, the user dials up the on-line network's access number and connects to the on-line network. The user can then send and receive e-mail to and from other users of the on-line network and, provided that the on-line network is connected to the Internet, with those having an Internet e-mail address. An alternative method to connect with the Internet is via an Internet Service Provider. Using a modem, the user dials the access number of the Internet Service Provider, and establishes a connection with a computer "directly" connected to or part of the Internet. The user can then operate an e-mail program, such as Eudora, to send and receive e-mail over the Internet” (col 1, line 55-col 2, line 5).

Shaw discloses advertising while online or utilizing the Internet or utilizing websites:

“(11) In many existing systems, users read and write e-mail while on-line, i.e., while connected to the on-line network or the Internet Service Provider. Costs of operating the on-line network (including communication and hardware costs) are higher when users are connected to the network. Also, some on-line networks and Internet Access Providers charge per minute of connect time. Accordingly, it is more cost effective if users read and write e-mail messages when off-line (e.g., when not connected to the on-line network).

(12) Some existing on-line services display advertising to users. For

Art Unit: 3622

example, advertisements are shown on part of the screen to users of the America Online network. When accessing certain World Wide Web sites on the Internet, advertisements are often included as part of the web page seen by the user.

Often in such systems, each user accessing a certain screen or site is shown the same advertisement. Sophisticated systems have the capability to change the advertisement after a certain period of time. However, in such systems the user must remain connected to the network to see the replacement advertisement” (col 2, lines 5-25).

Shaw discloses advertisements with different capabilities or features:

“(35) In the representative embodiment there are two types of advertisements. Banner advertisements 800 are displayed at step 501 when the user is reading and creating e-mail messages, or performing other administrative tasks, e.g., moving e-mail messages between folders. In the representative embodiment, banner advertisements 800 are displayed in a box at the top right side of the window (see FIGS. 8 and 12). Showcase advertisements are displayed whenever the user is attempting to establish a connection with the server system 104 and when information is being transferred between the client computer 101 and the server system 104. The banner and showcase advertisements may be textual, graphical, or video data (or combinations thereof) and may be stored in a standard compressed data format, such as JPEG or MPEG, or in a proprietary format, or in an uncompressed format. Typically, advertisements are simple graphics files. Sounds may also be included” (col 13, lines 15-30).

Art Unit: 3622

Shaw discloses targeting a user based on a user profile or user characteristics:

“(36) Targeted Advertisements: When first using the system of the present invention, the user completes a member profile (or survey) at the client computer. The member profile records information about the user, e.g., hobbies, interests, employment, education, sports, demographics, etc. The client program transmits the member profile to the server system when the user's client program first establishes a connection with the server system (e.g., on initial sign-up). The member profile is stored in the database management system of the server system” (col 5, lines 5-15).

Shaw does not explicitly disclose that the advertisement is at least a portion of a web page adapted for the device.

However, Gerace discloses profiling users and tracking user characteristics (Fig. 3b) and that characteristics of the user device can be tracked and recorded (Fig. 3c) and tailoring an advertisement to a user based on the user device or that the advertisement is at least a portion of a web page adapted for the device:

“(18) Also for each user, there is a User Computer Object 37b and a User Interface Object 37c. For each user's computer, User Computer Object 37b provides an indication of the limitations and capabilities of the user's computer system. For example, User Computer Object 37b lists whether the user's system provides audio and/or video display, and what Web browser software is utilized by the user's system. An outline of the table/data set of a User Computer Object 37b in the preferred embodiment is illustrated in FIG.



Art Unit: 3622

3c (col 6, lines 13-22).

(53)...Ad Object 33d also provides references to graphic, sound, and multimedia portions of an advertisement. A text-only format of an advertisement is used for users receiving messages on their own E-mail service or on a text-only browser (e.g., Links systems for VAX/VMS operating systems) rather than through the messaging feature of program 31” (col 12, lines 47-55).

Gerace further discloses advertisements with varying characteristics:

“(19) The Sponsor Object categorizes advertisement or other sponsor provided information according to content and presentation, including colors used, size, shape, and whether audio and/or video components are involved. An advertiser profile building routine automates the process of identifying colors, size, shape, and whether video and/or audio are involved” (col 2, lines 5-10).

Gerace further discloses advertisements tailored to the user preferences/characteristics:

“(13) With respect to the advertisement module 75, program controller 79 obtains sponsor submitted advertisements from module 75 and generates a screen view formatted according to user preferences as determined from the psychographic profile in the user profiling member 73. That is, program controller 79 enables display of advertisements customized to the user, as to content and presentation (i.e., colors used, orientation on the screen, audio/video components, and the like). Program controller 79 obtains the content from the advertisement module 75 and the presentation details for the subject user from the user profiling member 73” (col 5, lines 15-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's tailoring or targeting an advertisement to a user based on user characteristics where user characteristics can include user device information to Shaw's targeting a user based on user characteristics and advertisements with different presentation capabilities. One would have been motivated to do this in order to present the advertisement in a format that is accessible and of interest to the user.

Also, Shaw and Gerace disclose utilizing computers and utilizing the Internet as a communications medium. And, the MPEP 2144.04 IV.A. states that a change in size is an obvious variation of the prior art and the MPEP 2144.04 V.A. states that making the device portable is an obvious variation of the prior art and the MPEP 2144.04 V.C. states that making the device separable is an obvious variation of the prior art. Therefore, it would be obvious to one skilled in the art that the computer of Shaw and Gerace that can be located in a variety of locations that communicates utilizing the Internet can be hand-held and/or portable. One would be motivated to do this in order to increase the utilization of the computer when traveling (as stated in both Shaw and Gerace).

Claim 7, 22: Shaw discloses the method of claim 1. Shaw further discloses that a base fee is paid by an advertiser for having the advertiser's advertisement displayed on the device (col 6, lines 35-40).

Claim 9, 24: Shaw discloses the method of claim 1. Shaw further discloses that the advertisement displayed on the device is targeted for specific users by the advertiser, wherein advertiser targeting of specific users comprises the steps of:

(a) receiving an advertisement with user preferences,

Art Unit: 3622

(b) identifying users that match the user preferences; and

(c) loading the advertisement on devices of users identified in step (b) (col 2, lines 40-50; col 5, lines 5-16).

Claim 10, 25: Shaw discloses the method of claim 9. Shaw further discloses that the advertisement is loaded on devices of users in real time (col 2, lines 13-24).

Claim 11, 26: Shaw discloses the method of claim 9. Shaw further discloses that the advertisement is loaded on devices of users during a subsequent sync operation (col 2, lines 25-32).

6. Claims 3, 5, 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Goldhaber (5,794,210).

Claim 3, 5, 18, 20: Shaw discloses the method of claim 1.

Shaw discloses charging a fee to an advertiser (col 6, lines 35-40).

Goldhaber does not explicitly disclose that a fee is paid by the advertiser for each pre-populated address field forwarded to the advertiser.

Goldhaber discloses charging per item(s) of content about a user provided to the advertiser (col 6, line 60-col 7, line 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's charging per item(s) of content about a user provided to the advertiser to Shaw's charging fees to an advertiser. One would have been motivated to do this in order to better charge for services or information relevant to an advertiser.

Art Unit: 3622

7. Claims 8, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Bandera (6,332,127).

Claim 8, 23: Shaw discloses the method of claim 1.

Shaw further discloses :

(a) accessing a user profile associated with the user of the device;

(c) selecting one or more advertisements based on one or more of the user profile; and

(d) transmitting the one or more advertisements selected in step (c) to the device (col 2, lines 40-50; col 5, lines 5-16).

Shaw discloses tracking at what time the user is presented certain content:

“(16) Accordingly, there exists a need for a targeted advertisement system that also can provide information as to the characteristics of those who were exposed to each advertisement, for how long the user was exposed, and at what times”(col 2, lines 54-59).

Shaw does not explicitly disclose time and location based targeting.

However, Bandera discloses targeting a user and targeting a user for advertising based on location and time (col 8, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bandera's targeting based on location and time to Shaw's targeting and time tracking. One would have been motivated to do this in order to better target a user with relevant advertising.

Bandera further discloses advertisements with varying format capabilities:

“(6) The Web server 24 is configured to dynamically generate a requested Web page 26 using a dynamic execution engine (DEE) 28 and one or more Web page

Art Unit: 3622

content objects. The DEE 28 defines the selection of content objects within the Web page and the layout of those content objects within the Web page 26 when displayed within a Web client (i.e., Web browser). Conventionally, each element of a Web page, including, but not limited to, divisions, sections, headings, paragraphs, images, lists, tables, and hyperlinks, may be represented by a content object. In addition, a content object may include audio and video files. It is understood, however, that a single content object may represent one or more of these Web page elements. Dynamic generation of Web pages is well understood by those skilled in the art and need not be described further herein” (col 4, line 60-col 5, line 10).

8. Claims 12, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Angles (5,933,811).

Claim 12, 27: Shaw discloses the method of claim 1.

Shaw does not explicitly disclose enabling a user of the device to conduct business with a provider, wherein revenue from said business is shared between the provider and a server that enables access to the provider.

However, Angles discloses sharing revenues between involved parties and that a purpose of advertising is inciting purchasing (col 4, lines 25-47; col 2, lines 30-35).

Angles further discloses both website providers and online/internet service providers (col 4, lines 16-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Angles revenue sharing to reduce costs to Shaw's charging for advertising. One would have been motivated to do this in order to better distribute and compensate for costs.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-12 and 16-27 have been considered but are not found persuasive.

On page 12 of the Applicant's Remarks dated 3/22/06, Applicant states that, "Neither Shaw nor Gerace teach or suggest, for example, the steps of

'displaying an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields. . .

pre-populating at least one field of the advertisement with address location information relating to the user of the device."

However, both Shaw and Gerace disclose utilizing computers and utilizing the Internet as a communications medium. And, the MPEP 2144.04 IV.A. states that a change in size is an obvious variation of the prior art and the MPEP 2144.04 V.A. states that making the device portable is an obvious variation of the prior art and the MPEP 2144.04 V.C. states that making the device separable is an obvious variation of the prior art. Therefore, it would be obvious to one skilled in the art that the computer of Shaw and Gerace that can be located in a variety of

Art Unit: 3622

locations that communicates utilizing the Internet can be hand-held and/or portable. One would be motivated to do this in order to increase the utilization of the computer when traveling (as stated in both Shaw and Gerace).

Also, Gerace discloses targeting users based on the display characteristics or capabilities of the display device (Rejection above; Fig. 3c; and below citation):

“(18) Also for each user, there is a User Computer Object 37b and a User Interface Object 37c. For each user's computer, User Computer Object 37b provides an indication of the limitations and capabilities of the user's computer system. For example, User Computer Object 37b lists whether the user's system provides audio and/or video display, and what Web browser software is utilized by the user's system. An outline of the table/data set of a User Computer Object 37b in the preferred embodiment is illustrated in FIG. 3c” (col 6, lines 11-21).

Please see the motivation in the Rejection above for the motivation to combine these features with Shaw.

Also, in regards to the pre-populating at least one field of the advertisement with address location information relating to the user of the device, please see the rejection above.

Hence, the combination of Shaw and Gerace renders obvious “displaying an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields. . .

Art Unit: 3622

pre-populating at least one field of the advertisement with address location information relating to the user of the device”.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a) Kanojia (2004/0181593) discloses targeting a user based on device characteristics;
- b) Batachia (2002/0082912) discloses targeting a user based on device characteristics.

This is a RCE of applicant's earlier Application No. 09/864,293. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the



Art Unit: 3622

grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran  
Primary Examiner  
4/18/2006